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EXAMINER

SHEIKH, HUMERA N

ART UNIT	PAPER NUMBER
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1615

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07/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/938,454	Applicant(s) COLLINS ET AL.	
	Examiner Humera N. Sheikh	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

Receipt of the Response after Non-Final Office Action, Applicant's Arguments/Remarks and request for extension of time (2 months-granted), all filed 05/03/07 is acknowledged.

Applicant has overcome the following rejection(s): The 35 U.S.C. §102(e) rejection of claims 1-8 and 13-20 over Collin (U.S. Patent No. 6,491,931) has been withdrawn, by virtue of Applicant's persuasive remarks.

The remaining rejections of record have been maintained.

Claims 1-24 are pending in this action. No amendments to the claims have been made. Claims 1-24 remain rejected.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 5, 6, 9, 10, 13, 14, 17, 18, 21 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Shah *et al.* (U.S. Pat. No. 6,387,405 B1).

The instant invention is drawn to a mascara comprising a silicone gel that comprises an organopolysiloxane elastomer and a silicone oil, wherein said mascara comprises less than about 1%, by weight, of wax.

Shah et al. ('405) disclose cosmetic compositions, such as mascaras comprising an organopolysiloxane elastomer dispersed in a hydrocarbon vehicle. The cosmetic compositions also comprise a silicone gel, combined with a compatible cosmetically acceptable carrier wherein the silicone gel comprises the elastomer dispersed in the vehicle. The cosmetic compositions are transfer resistant and produce a soft and powdery sensation on the skin (see Abstract). The cosmetic composition comprising an organopolysiloxane elastomer dispersed in a hydrocarbon vehicle provide for long-lasting and unique tactile properties (col. 2, lines 8-30); (col. 4, lines 29-36).

The hydrocarbon vehicle can be a volatile or non-volatile hydrocarbon oil. The silicone gel is prepared by dispersing the organopolysiloxane elastomer in the hydrocarbon vehicle (col. 31-49). The gels combined with the carrier permit the production of soft-focus and matte-finish products without feeling heavy, greasy or oily, or caking or dragging on the skin caused by the addition of solids and fillers (col. 2, lines 56-65). Preferably the silicone gel is polysilicone-11 (col. 3, lines 27-44).

Volatile and non-volatile silicone oils and combinations thereof are disclosed at column 3, line 55 – column 4, line 6.

Volatile oils disclosed include, for example, cyclic and linear silicones, such as hexamethylcyclotrisiloxane, octamethylcyclotetrasiloxane and decamethylcyclopentasiloxane or volatile linear dimethylpolysiloxanes (col. 3, lines 64-67).

Non-volatile silicone oils disclosed include dimethicone, dimethiconol, phenyl trimethicone, simethicone, organomodified versions and mixtures thereof (col. 4, lines 1-6).

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Film-forming agents are disclosed at column 4, lines 43-56. Film-forming agents improve the wear of the composition and can confer transfer-resistance to the makeup product. Examples of film-forming agents include natural waxes, polyethylene polymers, copolymers of polyvinylpyrrolidone, silicone resins and the like and may be present from about 0.1 to about 20% by weight of the composition.

Fillers are disclosed and include mica (col. 5, lines 30-34).

The Examples at columns 5-7 demonstrate various cosmetic formulations of the invention. Example 1, for instance demonstrates a make-up formulation comprising cyclomethicone/trimethylsiloxysilicate, isododecane, silicone gel, nylon-12, barium sulfate, mica, dyes and pigment and aluminum starch octenylsuccinate.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunkel *et al.* (US Pat. No. 6,524,598 B2).

The instant invention is drawn to a mascara comprising a silicone gel that comprises an organopolysiloxane elastomer and a silicone oil, wherein said mascara comprises less than about 1%, by weight, of wax.

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Sunkel *et al.* ('598) teach cosmetic compositions comprising organopolysiloxane elastomers and silicone oils wherein the composition may be in the form of a *mascara*, foundation, eye shadows, powders, blushers, lip color and the like (see reference column 2, lines 35-55); Examples, (particularly Example II); Claims 1, 13 and 20.

Silicone oils taught include *cyclomethicone* (see Examples). Film-forming agents taught include *polyurethanes* (col. 12, lines 8-11). Pigments, such as *mica* are listed at column 16, line 65 – col. 17, line 35. Exemplary organopolysiloxanes are taught at column 3, line 66 – col. 4, line 13.

Solidifying agents (*i.e.*, waxes; gelling agents) are taught and are present at a concentration of from about 0 to about 90% (col. 14, lines 55-65). This range of solidifying agents (*i.e.*, waxes) reads on Applicant's limitation of 'less than about 1%, by weight, of wax', recited in claim 1.

Example II at column 23 demonstrates a mascara composition comprising elastomer gels, silicone oils, pigments and the like. The mascara composition is applied to the lashes and/or eyebrows to provide softening, moisturization and conditioning.

The prior art explicitly teaches silicone gels comprised of organopolysiloxane elastomers, and silicone oils in mascara formulations. Applicants have not demonstrated any unexpected results, which accrue from the 'less than about 1%, by weight, of wax'. Sunkel *et al.* at column 14, lines 55-65, teach that solidifying agents (*i.e.*, waxes) are present at a concentration of from about 0 to about 90%. Sunkel *et al.* also teach that most preferably the solidifying agents (*i.e.*, waxes) are present at from about 1% to about 15% (col. 14, lines 58-59). The '0%' as well as the 'about 1%' solidifying agents taught by Sunkel *et al.* meet the 'less than about 1%, by

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weight, of wax' instantly claimed. The prior art vividly recognizes the concept of employing no amounts (0%) as well as low amounts (about 1%) of wax in cosmetic formulations, including mascaras. Moreover, the prior art teaches that the particular solidifying agent for use in the cosmetic compositions will depend upon the particular type of composition desired, *i.e. gel or wax-based*, the desired rheology, the liquid base material used and the other materials to be used in the composition (col. 14, lines 50-55).

Therefore, it is the position of the Examiner, that given the teachings of Sunkel *et al.*, it would be *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to use the specific cosmetic formulations of Sunkel *et al.* who teaches silicone gels comprised of organopolysiloxane elastomers, and silicone oils in mascara formulations comprising from about 0 to about 90% of solidifying agents (*i.e.*, waxes) to provide for an effective, long-wearing, low viscosity cosmetic composition. The expected result would be an improved, long-lasting mascara makeup product for application to keratinous fibers.

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Collin (U.S. Pat. No. 6,491,931 B1) in view of Shah *et al.* (U.S. Pat. No. 6,387,405 B1).

The instant invention is drawn to a mascara comprising a silicone gel that comprises an organopolysiloxane elastomer and a silicone oil, wherein said mascara comprises less than about 1%, by weight, of wax.

Collin ('931) teaches a make-up cosmetic composition for keratin fibers, such as mascara for application to eyelashes comprising at least one film-forming polymer in the form of particles in aqueous dispersion, wherein the at least one film-forming polymer is chosen from

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polyurethanes and fibers applied to keratinous fibers. A cosmetic composition comprising at least one film-forming polymer in the form of particles in aqueous dispersion, wherein the at least one film-forming polymer is chosen from polyurethanes, at least one wax and fibers applied to keratin fibers is also disclosed. A process for making up or caring for keratin fibers are also disclosed (see Abstract); (column 1, lines 29-63); Examples 1-3.

In a first embodiment, the cosmetic composition comprises fibers and at least one film-forming polymer in the form of particles in aqueous dispersion, wherein the at least one film-forming polymer is a polyurethane (col. 1, lines 46-51). This cosmetic composition reads on Applicant's claims 13-20, which recite a mascara that does not comprise wax.

In another embodiment, the cosmetic composition comprises fibers, at least one film-forming polymer in the form of particles in aqueous dispersion, and at least one wax, wherein the film-forming polymer is a polyurethane (col. 1, lines 52-56). The composition, which can comprise a wax, contains wax generally in an amount ranging from 0.5% to 40% by weight, relative to the total weight of the composition (col. 4, lines 28-38). The composition can comprise, in one embodiment, an amount of waxes (I) generally ranging from 0.1% to 20% by weight, relative to the total weight of the composition, and an amount of waxes (I) ranging from 1% to 10% by weight in another embodiment (col. 4, lines 39-58) (also see claims 51 & 55). These amounts read on Applicant's claims 1-8, which recite a mascara comprising less than about 1%, by weight, of wax.

Oils disclosed in the invention that imparts transfer-resistance properties, *i.e.*, good staying power, include volatile and non-volatile oils such as hydrocarbon-based oils, silicone oils, fluoro oils and mixtures thereof (col. 6, lines 5-20).

Volatile oils that can be used include volatile silicones, such as, for example, cyclic volatile silicones. Cyclic volatile silicones disclosed include, for example, octamethylcyclotetrasiloxane, decamethylcyclopentasiloxane and hexadecamethylcyclohexasiloxane; and volatile linear silicones such as for example, octamethyltrisiloxane, heptamethylhexyltrisiloxane, heptamethyloctyltrisiloxane and decamethyltetrasiloxane. Volatile fluoro oils such as nonafluoromethoxybutane and perfluoromethylcyclopentane may also be used (col. 6, lines 34-44).

Non-volatile oils, including non-volatile hydrocarbon-based oils, silicone oils and fluoro oils are also disclosed. Suitable non-volatile silicone oils of low viscosity, such as linear polysiloxanes are disclosed and include for example, polydimethylsiloxanes (PDMSs), phenyl dimethicones, phenyl trimethicones and polyphenylmethylsiloxanes (col. 6, line 55 – col. 7, line 48).

The cosmetic compositions can comprise pigments, such as for example, mica and coated mica (col. 8, lines 15-47).

According to Collin, the make-up composition has good staying power over time, is resistant to water, in particular while rubbing, imparts good lengthening and adhering properties to the eyelashes and coats them without forming blobs. In addition, the make-up composition does not crumble (col. 1, lines 29-45).

Examples 1-3 at columns 9-10 demonstrate various mascara compositions according to the invention. The mascaras obtained demonstrate good staying power, transfer-resistance and good lengthening properties to the eyelashes.

Collin does not teach polysilicone-11.

Shah et al. ('405) teach cosmetic compositions, such as mascaras comprising an organopolysiloxane elastomer, a hydrocarbon vehicle and a silicone gel, preferably polysilicone-11. The silicone gel (*i.e.* polysilicone-11) comprised of the elastomer dispersed in the hydrocarbon vehicle provides for a soft, stable, viscous gel or gel-like material (see reference column 3, lines 27-44).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the silicone gel, polysilicone-11 of *Shah et al.* within the make-up product of Collin. One of ordinary skill in the art would be motivated to do so with a reasonable expectation of success because *Shah et al.* teach polysilicone-11 in their cosmetic formulations (*i.e.*, mascaras) and they teach that polysilicone-11 is a preferred gel, which provides for a soft and stable cosmetic formulation having gel or gel-like properties. The expected result would be an improved and stabilized mascara product for coating keratinous fibers.

Response to Arguments

Applicant's arguments filed 05/03/07 have been fully considered and were found partially persuasive.

35 U.S.C. §102(e) Rejections:

Firstly, Applicant argued regarding the 35 U.S.C. §102(e) rejection of claims 1-8 and 13-20 over Collin ('931) stating, "Claim 1 recites a mascara comprising a silicone gel that comprises an organopolysiloxane elastomer and a silicone oil, wherein said mascara comprises less than about 1% by weight of wax. Collin fails to disclose or suggest such a mascara which comprises such a silicone gel. While Collin does disclose the use of silicone oils, Collin does not disclose

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silicone gels comprising an organopolysiloxane elastomer and a silicone oil, as recited in claim 1 of the present invention."

Applicant's arguments have been fully considered and were found persuasive.

Accordingly, the 35 U.S.C. §102(e) rejection of claims 1-8 and 13-20 over Collin (U.S. Patent No. 6,491,931) has been withdrawn.

Secondly, Applicant argued regarding the 35 U.S.C. §102(e) rejection of claims 1, 2, 5, 6, 9, 10, 13, 14, 17, 18, 21 and 22 over Shah et al. ('405) stating, "As noted in the Office Action, Shah et al. does disclose "[t]he compositions of the present invention can be used in any type of makeup or, skin or sun care product. Typical examples include foundations, eyeshadows, eyeliners, mascaras, blushes, powders, lipsticks, lipglosses, lip paints, oil control skin mattifiers, and sunscreen lotions." However, no examples of mascaras are disclosed in Shah et al. Thus, Shah et al. does not teach any mascara. In fact, the only examples disclosed in Shah et al. are skin foundations and lip paints, which are not mascaras. Thus, one of ordinary skill in the art would not look to Shah et al. as a teaching, or suggesting, the claimed mascaras of the present invention.

Applicant's arguments have been fully considered but were not found persuasive. As noted by Applicant, Shah et al. teach that their "compositions are used in any type of makeup", of which "mascaras" is also included (col. 4, line 34 of '405). While Shah only illustrates two examples in their patent, namely a skin foundation and lip paint formulation, it is the position of the Examiner that the teachings of the references are not limited solely to the examples demonstrated therein. In this instance, Shah clearly discloses that "mascaras" are amongst the makeup types whereby their compositions can be suitably used. The reference discloses each element of the instant claim limitations and thus, meets the anticipation criteria.

35 U.S.C. §103(a) Rejections:

Applicant argued regarding the 35 U.S.C. §103(a) rejection of claims 1-24 over Sunkel et al. ('598) stating, "In the Prior Response, Applicants submitted a Declaration Under 37 CFR 1.132 by Lien Ly ("Declaration"), which demonstrated that the viscosity of the Wax Mascara increased on average by over one hundred percent, while the Wax-free Mascara, unexpectedly only increased on average nineteen percent (five times less than the Wax Mascara). In response to the Prior Response, the Office Action stated that the Declaration had been fully considered but was not deemed persuasive, as "Sunkel et al. teach '0 to 90% of solidifying agents, of which waxes are included." See Page 13 of the Office Action. However, as previously argued, Sunkel et al. relates to various types of cosmetic compositions. Sunkel et al. does not disclose, nor suggest, how one would make a mascara

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with 0% wax. In fact, Sunkel et al actually teaches away from such as the mascara set forth in Example II of Sunkel et al. comprises 11.25% of wax. Thus, Sunkel et al. does not teach nor suggest the mascara recited in independent claim 1 of the present application, which comprises less than about 1%, by weight, of wax”.

Applicant’s arguments have been fully considered but were not found persuasive. Sunkel et al. teaches compositions that comprise organopolysiloxane elastomers and silicone oils and also teaches that their composition may be a mascara (col. 2, line 38). Thus, the various cosmetics taught by Sunkel, explicitly include mascara formulations. The argument that “Sunkel does not teach how one would make a mascara with 0% wax” was not persuasive since Sunkel teaches mascara forms and also teaches ‘0 to 90%’ of solidifying agents of which waxes would be included. Thus, one of ordinary skill in the art reading the teachings of Sunkel would presume that the cosmetic forms, particularly mascara, can be formulated with either little or no amount of solids (including wax) incorporated in them, based on Sunkel’s teachings. The argument that “Sunkel teaches away from such a mascara as set forth in Example II which comprises 11.25% of wax” was not persuasive since, as delineated above, the teachings of a prior art reference are not limited to the examples demonstrated therein; the reference teachings as a whole must be considered. In this case, Sunkel teach that their various cosmetics would include mascaras and also teach that 0% of solidifying agents can be used. Thus, Applicant’s arguments were not persuasive.

Applicant argued regarding the 35 U.S.C. §103(a) rejection of claims 1-24 over Collin in view of Shah et al. stating, “Neither Collin nor Shah et al. disclose, nor suggest a reduced-wax mascara comprising the claimed silicone gel. In fact, Shah et al. fails to disclose the manufacture of any mascara.”

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These arguments were not persuasive. Shah et al. disclose that suitable cosmetic forms include mascaras (col. 4, line 34). The argument that "Shah fails to disclose the manufacture of any mascara" was not persuasive since, for the record, the instant claims are drawn to composition claims and not a method of making or manufacturing. Thus, Applicant's argument does not establish the scope of claims being presented. Moreover, it is the position of the Examiner that the prior art is clearly suggestive of a cosmetic formulation as claimed. The prior art recognizes incorporation of the same components for use in the same field of endeavor and purpose as that desired by Applicant. The instant invention would be *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

For these reasons, the rejections of record have been maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Humera N. Sheikh whose telephone number is (571) 272-0604. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday during regular business hours. (Telework on Wednesdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Humera N. Sheikh

Primary Examiner

Art Unit 1615

July 05, 2007


HUMERA N. SHEIKH
PRIMARY EXAMINER

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